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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,163	04/18/2001	William Simpson-Young	169.2020	7407
5514	7590	01/13/2005		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
			EXAMINER LIN, WEN TAI	
			ART UNIT 2154	PAPER NUMBER

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/836,163	SIMPSON-YOUNG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Wen-Tai Lin	2154	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2004 and 12 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 18-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/30/03 - 11/12/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-37 are presented for examination. Claims 18-36 are provisionally withdrawn from further consideration in accordance with Applicant's response to the previous restriction requirement.

2. In response to the previous restriction requirement Applicant argues: "Groups I, II and III are not so distinct as to require examination in different applications since, as alleged in the Office Action, they are all related as sub-combinations of one another. Accordingly, it is believed that there would not be an undue burden on the Examiner to examine all of the claims in a single application since it is believed that a search of art relevant to one group would necessarily encompass the others."

The examiner disagrees with Applicant's argument. Specifically, appropriate explanation has been given in the previous office action showing that each of these groups are classified in three different subclasses directly under class 709, for which each requiring different field of searches (see the definitions of subclasses 201, 227 and 220). Thus although groups I, II and III are related inventions (i.e., related as sub-combinations of one another), they are nevertheless distinctive under the criteria of MPEP § 806.05(c) - § 806.05(i) (see MPEP 808.02).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 5-6 and 10 are rejected under 35 U.S.C. 112 because the following terms lack antecedent basis:

In claims 2 and 10, "said second additional devices";

In claim 5, "said entities"; and

In claim 6, "said incorporation".

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-11, 13-15 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Giese; et al.[U.S. Pat. No. 6728267].

6. As to claim 1, Giese; teaches the invention as claimed including: a method of automatically establishing a desired communication between an originating device and a target device, said originating device and said target device each having an associated profile [col.16, lines 1-43], said method comprising steps of:

(i) determining a profile compatibility between said originating device and said target device [Figs.16-17; col.15, lines 47-52];

(ii) establishing said desired communication, if a direct profile compatibility between said originating device and said target device is found, said establishing being directly between said originating device and said target device [e.g., terminals 88 and 86 of Fig.18 lie within the same network and are capable of communicating with the same voice format can be linked directly]; and

(iii) establishing said desired communication, if said direct profile compatibility between said originating device and said target device is not found, said establishing being indirectly between said originating device and said target device by incorporating at least one additional device [e.g., a gateway], said at least one additional device having an associated profile, said incorporation forming linked device pairs among said originating device, said target device and said at least one additional device, whereby said incorporation establishes a direct profile compatibility between each said linked pair of said devices [e.g., terminals such as 88 and 92 of Fig.18 reside in different network require communication channel established via a gateway (94a, Fig. 18)].

7. As to claims 2-3, Giese; further teaches that said incorporating comprises steps of:

(a) communicating, by one of said originating device [e.g., 88, Fig.18] and said target device [e.g. any terminal residing in the ATM or TDM networks of Fig.18], to a first additional device [e.g., 98, Fig.2], thereby forming linked device pairs among said originating device, said target device and said at least one additional device;

(b) establishing said desired communication, if direct profile compatibility is established between each said linked pair of devices [e.g., devices 88 and a terminal with the ATM network can be established with a gateway];

(c) communicating, by one of said originating device, said target device and said first additional device, if said direct profile compatibility is not established between each said linked pair of devices, to a second additional device, thereby forming linked device pairs among said originating device, said target device, said first and said second additional devices [e.g., connection between 88 and 90 is established via a first and a second gateway via bridge 92 (see also col.16, line 1 –col.17, line 12)]; and

(d) repeating steps (b) and (c) until said desired communication is established, said direct profile compatibility being established between each linked pair of devices [col.17, lines 13 – 20; i.e., the illustrated example can be repeatedly applied to a larger WAN].

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8. As to claim 4, Giese; further teaches that each said device comprises one of a device or a service [i.e., the gateways or bridges are devices but may also be viewed as services].

9. As to claims 5-9, since the features of these claims can also be found in claims 1-4, they are rejected for the same reasons set forth in the rejection of claims 1-4 above.

10. As to claim 11, Giese; further teaches that said message comprises at least one of a command and a data value [col.9, lines 35-39].

11. As to claims 10, 13-15 and 37, since the features of these claims can also be found in claims 1-9 and 11, they are rejected for the same reasons set forth in the rejection of claims 1-9 and 11 above.

As for the additional limitation in claim 10 requiring that said communicating (for forming the linked device pairs) does not require understanding by said communicating device of said message: it is noted that Giese teaches such feature at col.3, lines 6-10.

As for the additional limitation in claim 10 requiring the communication system to comprise means for searching said network to identify an intermediate service having a profile compatibility with said service and by which intermediate functional communications between said service and said intermediate service can be

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established: it is noted that Giese teaches such feature at col.4, lines 16-19; col.7, lines 24-29.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giese; et al.(hereafter "Giese;")[U.S. Pat. No. 6728267], as applied to claims 1-11, 13-15 and 37 above, further in view of Zintel; [U.S. Pat. No. 6779004].

14. As to claims 12 and 16, Giese; does not specifically teach that said messaging protocol is the Extended Markup Language (XML).

However, in the same field of endeavor Zintel; teaches that XML can be used as messaging protocol [Zintel;: col.2, line 64 – col.3, line 8].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form Giese;'s messages in XML because it is well known that XML supports structured information with designated tags that can be used for



extracting command and its associated parameters that are embedded in Giese;'s message.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Kusunoki; [U.S. Pat. No. 6128314];

Krishnamurthy; et al. [U.S. Pat. No. 6389464];

Nakamura; et al. [U.S. Pat. No. 6590677];

Dutta [U.S. PGPub 20010047383];

Flavin; et al. [U.S. Pat. No. 6108308];

Nieminen; et al. [U.S. Pat. No. 6578075]; and

Williams; et al. [U.S. Pat. No. 6202096].

**16.** A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703) 872-9306 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

December 17, 2004

*Wen-Tai Lin*  
12/17/04